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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/551,457	09/30/2005	Masao Suzuki	053197	4414

38834 7590 08/31/2007
WESTERMAN, HATTORI, DANIELS & ADRIAN, LLP
1250 CONNECTICUT AVENUE, NW
SUITE 700
WASHINGTON, DC 20036

EXAMINER

RACHUBA, MAURINA T

ART UNIT	PAPER NUMBER
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3723

MAIL DATE	DELIVERY MODE
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08/31/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/551,457

Applicant(s)

SUZUKI ET AL.

Examiner

Maurina Rachuba

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 13 June 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,2 and 4-24 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,2 and 4-24 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date 7/19/07.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

2. Claims 1, 2, 4-15, and 19-23 are rejected under 35 U.S.C. 102(a) as being clearly anticipated by Nishiyama et al, WO 03/032379. Please refer to pages 2-9 of US 2004/0224623, the English language equivalent of '379.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 16-18 and 24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Nishiyama et al, WO 03/032379 in view of Koike et al, 6,544,104. '379, please refer to US 2004/0224623, the English language equivalent, discloses the claimed invention except for the pad having the function of allowing transmission of a light having a wavelength in the range of 190 to 3,500 nm. '104 teaches that it is old and well known to produce a polishing pad that allows the transmission of light in any desired wavelength. It would have been obvious to one of ordinary skill to have provided either '645 or '623 with the ability to transmit light in any desired wavelength as

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taught by '104, column 1, lines 42-50, to allow efficient *on situ* monitoring of the polishing process.

5. Claims 1, 2, 7, 9, 10, 11, 19, 20, 22 and 23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tolles, 6,533,645 in view of Jensen, Jr. 4,728,552. '645 discloses the claimed invention, but uses a phenol resin, a thermosetting resin. In a similar polishing pad, '552 teaches using a urethane, a thermoplastic resin, to bind fibers together to form a polishing pad. Because both of the references teach binding fibers in a resin, it would have been obvious to one of ordinary skill to substitute one resin for another, to achieve the predictable results of providing a polishing pad that is soft, supple, flexible, absorbent and of great structural integrity, see '552, column 4, lines 23-25.

Response to Arguments

6. Applicant's arguments, see pages 6 and 7, filed 13 June 2007, with respect to the rejection(s) of claim(s) 1, 2, and 4-24 under US 2004/0224623 and 6,533,645 have been fully considered and are persuasive. Therefore, the rejection has been withdrawn. However, upon further consideration, a new ground(s) of rejection is made in view of WO 03/032379. Applicant correctly argues that the PCT filing date of US 2004/0224623 cannot be relied on under 35 USC 102(e). However, WO 03/032379, published before the international filing date of the pending application is valid under 35 USC 102(a). It is also noted that applicant has provided translations of the claims only in attempting to perfect the priority, and is "considering" filing sworn translations. Unfortunately, the examiner cannot rely on such to overcome the rejection under WO 03/032379. This

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action is made non-final to allow applicant fair opportunity to respond to the rejections under WO 03/032379. Further, the examiner agrees that Tolles does not disclose the use of a thermoplastic resin, however, it is the examiner's position that Tolles, as modified by Jensen, makes obvious applicant's claimed invention.

7. Koike et al, 6,544,104 is included on the Notice of References Cited, included herewith.

Conclusion

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Maurina Rachuba whose telephone number is 571 272 4493. The examiner can normally be reached on Monday-Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph Hail can be reached on 571 272 4485. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/M. Rachuba/
Primary Examiner
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